

### **REMARKS**

Applicant has amended claims 1 and 3; no new matter has been added.

#### **I. REJECTION OF CLAIMS UNDER 35 U.S.C. § 112**

The Examiner's rejection of claims 1 and 3 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claim 1 to delete the terms "low cost," "small," and "aesthetic." Claim 1 is also amended to replace the phrase "a debris sized bed" with "a bed sized to receive debris." Claim 3 is amended to delete the terms "economically" and "small." In light of these amendments, the Examiner's rejection of claims 1 and 3 under 35 U.S.C. § 112, second paragraph, cannot be sustained. Applicant respectfully requests that the Examiner withdraw the rejection and allow said claims.

#### **II. REJECTION OF CLAIMS UNDER 35 U.S.C. § 103(a)**

The Examiner's rejection of claims 1-3 under 35 U.S.C. § 103(a), as being unpatentable over Strickland, U.S. Patent No. 4,979,865, in view of the Norsic non-patent literature, is respectfully traversed.

##### **A. Claims 1 and 2**

Contrary to the Examiner's statements on page 3 of the current Office Action, Strickland does not teach a grasping means as defined by Applicant's specification and drawings. The Strickland reference describes "[a] suitable hook or other grappling device 37 [that] may be releasably attached to the free end 36 of the cable 30. . ." See Strickland, column 3, lines 32-34; column 4, lines 63-68; and Figures 1, 2, and 4. With reference to Strickland's drawings, a "grappling device" refers to a hook. See also The Merriam-Webster Dictionary (1998), definition

of the word “grapple” referring to seizing or holding with a hook implement. Applicant’s amended claim 1 refers to a means for grasping and not to a hook or other grappling device. Paragraph 18 of Applicant’s specification defines the “means for grasping” of amended claim 1 as “a hydraulic lift arm 16 and a pair of gripping arms that are mechanically controlled by a hydraulic control 20 that manipulates the position of the debris collectors 18 relative to the vehicle 14 and the truck bed 22” that are attached to a vehicle. See also Applicant’s Figure 2. The Strickland reference neither describes in its specification or claims nor illustrates by its drawings any hydraulic lift arm and a pair of gripping arms that are mechanically controlled by a hydraulic control.

The means for grasping element of amended independent claim 1 must be construed to cover the corresponding structure and material described in the specification and equivalents thereof. 35 U.S.C. § 112, sixth paragraph. Clearly, the hook and grappling device of Strickland are not the same as the elements described by Applicant’s specification with respect to Applicant’s grasping means in claim 1. Thus, in construing the means for grasping of amended claim 1 to cover the corresponding structure and material described in the specification and equivalents thereof, the Examiner has failed to demonstrate that the Strickland reference discloses the grasping means as claimed by Applicant.

Moreover, Applicant has reviewed the Norsic reference and disagrees with the Examiner’s characterization of Applicant’s “small steel rectangular trash bin less than 9 feet long, less than 6 feet wide, and less than 6 feet high for receiving construction debris” as being the same as the irregularly shaped front load and rear load dumpsters of Norsic. Norsic illustrates several dumpsters that include conventional (and more costly) means for engaging a loading machine that lifts the dumpster and empties the contents of said dumpster into a garbage truck or other

similar vehicle. Applicant's rectangular trash bin is shaped as a small parallelepiped so as to be unobtrusive when located on a construction work site. Applicant's trash bin also does not include any means for engaging a loading machine, but instead, relies upon the means for grasping of claim 1 to remove debris from the trash bin and to place said debris within a bed of a vehicle for removal. Applicant's trash bin is not designed or intended to be lifted as are the dumpsters shown in Norsic. The Examiner is applying the "obvious to try" test to Applicant's invention in determining whether said invention is obvious under 35 U.S.C. § 103(a).

Regarding the "obvious to try" test, the Court of Customs and Patent Appeals has previously stated:

[A]pplication of the "obvious to try" test would often deny patent protection to inventions growing out of well-planned research which is, of course, guided into those areas in which success is deemed most likely. These are, perhaps, the obvious areas to try. But resulting inventions are not necessarily obvious. Serendipity is not a prerequisite to patentability. Our view is that "obvious to try" is not a sufficiently discriminatory test.

In re Lindell, 385 F.2d 453 (C.C.P.A. 1967). Therefore, the Examiner's assertion that Applicant's invention is obvious due to the Examiner's belief, in hindsight, that Applicant's use of the small steel rectangular trash bin and means for grasping was obvious to try does not set forth a sufficiently discriminatory test upon which the Examiner may rely to reject Applicant's claims under 35 U.S.C. § 103(a). None of the prior art references supplied by the Examiner teach or suggest the combination of a small steel rectangular trash bin and the means for grasping described by Applicant's claim and specification. While Applicant's invention may be simple in design, "[s]implicity is not inimical to patentability." In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Thus, the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) cannot be sustained. Applicant respectfully requests that the Examiner withdraw the rejection and allow claim 1.

Dependent claim 2 ultimately depends upon amended independent claim 1, and thus, incorporates by reference all of the elements and limitations of independent claim 1. 35 U.S.C. § 112, fourth paragraph. This includes the novel features disclosed in claim 1 of a small steel rectangular trash bin and the means for grasping. As explained above, these novel features of Applicant's invention are not disclosed by the Strickland and Norsic references cited in the current Office Action. Therefore, the Examiner's rejection of Applicant's claim 2 under 35 U.S.C. § 103(a) cannot be sustained. Applicant respectfully requests that the Examiner withdraw the rejection and allow claim 2.

**B. Claim 3**

Applicant has amended subpart 2 of claim 3 to state "using a truck having means for grasping and a trash storing bed at said site to periodically haul away trash; wherein said means for grasping is used to remove trash from said trash bin and to place the trash within said trash storing bed of the truck." As explained in Section II.A. above, the means for grasping element of amended independent claim 3 must be construed to cover the corresponding structure and material described in the specification and equivalents thereof. 35 U.S.C. § 112, sixth paragraph. Clearly, the hook and grappling device of Strickland are not the same as the elements described by Applicant's specification with respect to Applicant's grasping means in claim 3. Thus, in construing the means for grasping of amended claim 3 to cover the corresponding structure and material described in the specification and equivalents thereof, the Examiner has failed to demonstrate that the Strickland reference discloses the grasping means as claimed by Applicant.

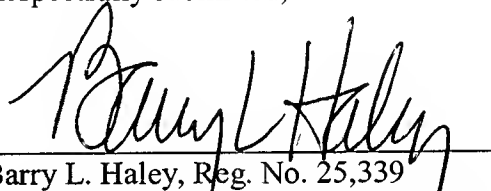
On page 4 of the Office Action, the Examiner states that it would have been obvious to one having ordinary skill in the art at the time of the invention "to modify the method taught by

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Strickland with those taught by Norsic in order to allow the system to work without needing a plurality of containers to hold the debris as it waits for removal. With respect to this statement by the Examiner, Applicant maintains and reincorporates herein Applicant's argument from Section II.A. above concerning Applicant's small steel rectangular trash bin and the obvious to try test used by the Examiner to reject the method of claim 3.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Barry L. Haley", is written over a horizontal line.

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